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EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 12/20/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/733,611

Applicant(s)

W. P. Singh

Examiner

Sabiha Qazi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 8, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) 12-16 and 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 12-16 and 18-25 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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***Restriction/Election - 35 U.S.C. 121***

Instant invention is drawn to methods of sterilizing with dicarboxylic acids.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 17 are drawn to method of preparing sterile solution, classified in class 424, subclass 616, class 514, subclass 557, 558.
  - II. Claim 12 is drawn to classified in class 424, subclass 29.
  - III. Claims 13, 15 and 16 are drawn to classified in class, subclass, class 514, subclass.
  - IV. Claim 14 is drawn to method of group I when one or more carboxylic acids are synthesized.
  - V. Claim 17 is drawn to method of sterilizing solution not covered by groups I-III.
  - VI. Claim 18-25 are drawn to method and composition not covered by any of the groups cited above.
- The inventions are distinct, each from the other because of the following reasons:

Claims 1-25 belong to different methods of preparing sterile solutions. Each of them require a separate database search in addition to other searches.

Because these inventions are distinct for the reasons given above acquire a separate status in the art because of their recognized divergent subject matter and the search required for Group I is not required for any other Group, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Jefferey Street on 10/9/01, a provisional election was made with traverse to prosecute the invention of group I, claims 1-11 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-16 and 18-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. It is suggested that in order to advance prosecution, the non elected subject matter be canceled when responding to this office action.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lokkesmoe et al. (US Patent 5,674,538). Lokkesmoe teaches a method of controlling microbial growth in aqueous stream by using percarboxylic acid which embraces Applicant's claimed invention. See the entire document especially lines 34-67, col. 4; lines 18-67, col. 6; examples and claims of the prior art. Instant claims are drawn to sterilizing solution which comprises storing dry solid comprising one or more dicarboxylic acid and then dissolving said solid carboxylic acid into water. Instant claims differ from the reference in dissolving a solid acid in water.

It would have been obvious to one skilled in the art to be motivated at the time of invention to prepare additional beneficial antimicrobial composition especially when prior art teaches the antimicrobial formulation in the form of solution for the same use. After solution is prepared the activity of the solution is expected to be the same, no matter how it is prepared. Therefore, in absence of any criticality or unexpected results instant invention is considered obvious. In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### ***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

12/1/01



Sabiha N. Qazi, Ph.D.

Primary Examiner,

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